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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,371	12/31/2003	Marshall Medoff	08895-006002	4897

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FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

BEFUMO, JENNA LEIGH

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/750,371

Applicant(s)

MEDOFF ET AL.

Examiner

Jenna-Leigh Befumo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7,10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7,10 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/04, 6/04, 9/04, 1/05, 3/05
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Preliminary Amendment

1. The Preliminary Amendment submitted on December 31, 2003, has been entered.

Claims 1 – 6, 8, 9, and 12 – 36 have been cancelled. Therefore, the pending claims are 7, 10, and 11.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 7, 10, and 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 3, 8, and 11 of U.S. Patent No. 5,952,105. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to texturized fibrous material which is made from cellulosic material which has been shredded to expose internal fibers in the paper material.

4. Claims 7, 10, and 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9, 12, 13, and 14 of U.S. Patent No. 6,207,729. Although the conflicting claims are not identical, they are not patentably distinct

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from each other because both sets of claims are drawn to texturized fibrous material which is made from cellulosic material which has been shredded to expose internal fibers in the paper material.

5. Claims 7, 10, and 11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 30 – 35 of copending Application No. 10/615,748. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to texturized fibrous material which is made from cellulosic material which has been shredded to expose internal fibers in the paper material.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 7, 10, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. The term “internal fibers are substantially exposed” in claim 7 is indefinite. What is meant by “substantially exposed”? Do a “substantial” amount of fibers need to be at least partially “exposed”? Or, does a “substantial” portion of the individual fiber need to be “exposed”? Additionally, how much exposure is considered “substantial”? Claims 10 and 11 are rejected due to their dependency on claim 7.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Erickson (4,020,212).

Erickson discloses a finishing agent composition which is applied to polyolefin fiberfill (column 1, lines 11 – 14). The finishing agent comprises a organopolysiloxane (column 1, line 64 – column 2, line 10). Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or an obvious variant from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the Applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983). In this case, shearing the poly-coated paper would produce fibers which have been torn apart from each other and have a polymer coating on at least a portion of said fibers. Thus, the material taught by Erickson which comprises a fiberfill, i.e., staple fibers, with a polymer coating, i.e., the organopolysiloxane, is the same as the material produced by the shearing the poly-coated paper. Therefore, claim 7 is rejected.

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11. Claim 7 rejected under 35 U.S.C. 102(b) as being anticipated by Lamb, Sr. (5,137,668).

Lamb, Sr. discloses a method for producing a pressboard using shredded paper coated with a thermoplastic material (abstract). Internal fibers would inherently be exposed when the paper is shredded, on at least the torn or ripped edges. Therefore claim 7 is rejected.

12. Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Mamers et al. (4,188,259).

Mamers et al. is drawn to a method for recovering fiber from laminated carton boards (abstract). The carton boards can include laminated paper products used for packaging juices and milk (column 1, lines 9 – 11). Mamers et al. liberated the pulp material by placing shredded pieces of the laminate in a pulping liquor, which is heated to a temperature above the melting temperature of the thermoplastic material in the laminate, followed by cooling the liquor to a temperature below the softening point of the thermoplastic material, subjecting the mixture to defibration forces to produce thermoplastic fragments and cellulosic fibers, and finally, separating the materials (column 2, lines 28 – 48). The pulp may then be cleaned of the remaining thermoplastic material by known means, producing clean separated cellulosic fibers (column 7, lines 33 – 35). Therefore, the fibers are completely separated from the thermoplastic material and 100% exposed. Further the defibration process would also texturized the fibers to some degree. Thus, claim 7 is anticipated.

13. Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by Nishibori (5,871,161).

Nishibori et al. discloses a process for individually collecting layers from a laminated film by shredding the laminated material into a plurality of fragments and then peeling and separating the materials in the fragments (abstract). Materials which can be separated include

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various types of laminated paper products including milk cartons (column 4, line 61 – column 5, line 25). The peeling and separating step separates the individual layers producing disentangled minute fibers, thin strips of plastic fragments and thin strips of foil fragments (column 8, lines 59 – 65). The fibrous paper layer has 100% of the internal fibers exposed via the peeling and separating step. This process would also inherently texturized the fibers to some degree. After separating the fibers, the fibrous material is passed through a screen and collected in a collecting tank (column 9, lines 10 – 29). Thus, claim 7 is anticipated.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erickson or Lamb, Sr.

The features of Erickson and Lamb, Sr. have been set forth above. Both Erickson and Lamb, Sr. fail to teach the bulk density of the texturized material. It would have been obvious to one having ordinary skill in the art to choose the claimed range since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CPA 1980). In this case, it would be obvious to vary to the density of the texturized material for various end uses depending on the desired end properties such as insulation, weight, and hand. Therefore, claims 10 and 11 are rejected.

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16. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mamers et al. or Nishibori.

The features of Nishibori and Mamers et al. have been set forth above. While Nishibori and Mamers et al. discloses the fibers are separated to form pulp and collected to be used later, Mamers et al. and Nishibori fail to teach the bulk density of the separated fibers. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the claimed, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215. In this case, it would have been obvious to one of ordinary skill in the art to vary the bulk density of the pulp material for various end uses depending on the desired end properties, such as insulation, cushioning, weight, and hand. Therefore, claims 10 and 11 are rejected.

Further, the pulp fibers in Nishibori are collected by dropping through a screen. Therefore, the collected pulp would have a low bulk density since Nishibori et al. doesn't teach compressing the pulp as it is being collected.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (571) 272-1472. The examiner can normally be reached on Monday - Friday (8:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Jenna-Leigh Befumo', with a stylized flourish at the end.

Jenna-Leigh Befumo
September 6, 2005